



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Arling et al. |) | Examiner: | Yenke, Brian P. |
| | |) | | |
| Serial No.: | 09/718,931 |) | Art Unit: | 2614 |
| | |) | | |
| Filed: | November 21, 2000 |) | Attorney Doc.: | 81230.578001 |
| | |) | | |
| Title: | Media Return System |) | | |

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 6-9, 11, and 15-19 which rejection was set forth in the Office Action mailed March 3, 2006.

In accordance with MPEP § 1204.01, a new Notice of Appeal is being filed concurrently herewith for the purpose of reinstating the previously filed request for appeal.

This Appeal Brief is being filed in triplicate with the requisite fee.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 34th day of March, 2006.

By: Ranni Matar
Ranni Matar

I. Real Party In Interest

The real party in interest is Universal Electronic Inc.

II. Related Appeals And Interferences

There are no appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 6-9, 11, and 15-19 remain pending and, having been finally rejected, are the subject of this appeal.

A clean, double spaced copy of these pending claims may be found in the attached Claims Appendix .

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

As described in the background and summary of the subject application for patent, the claimed invention is generally directed to a system and method which has the advantage, unrecognized by any reference of record, of allowing any media playing device, even those media playing devices that do not have the programming necessary for performing a "return to channel" operation, to nevertheless be provided with a return to channel feature through the use of a remote control.

More particularly, as described in the specification (e.g., page 10, lines 14+) and illustrated in the figures (e.g., Figs. 2 and 5-7), the claimed invention effects a return to a primary

channel in a media device adapted to play media and not equipped with a return to channel feature by setting a timer (54) in a remote control (23') that times a predetermined interval in response to a user first input of the remote control (23'), e.g., user activation of the surf button (50), and by storing a primary channel in memory (88) in response to a user second input of the remote control (which may also be a user activation of the same surf button (50) as illustrated in Fig. 2 and as set forth in, for example, claim 17). Then, in response to expiration of the predetermined interval timed by the timer (54) and without regard to a current state of any media being received by the media device, the claimed system and method causes a wireless transmitter of the remote control (23') to transmit a command signal corresponding to the primary channel stored in memory (88) to the media device adapted to receive the primary channel to thereby cause the media device to return to the primary channel, e.g., to automatically end a process of user "channel surfing."

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether a rejection of claims 6, 8, and 15-18 under 35 U.S.C. § 102 based upon Hesse (U.S. Patent No. 5,287,109) can be maintained when Hesse simply fails to disclose, teach, or suggest the identical invention set forth in these claims.
2. Whether a rejection of claims 6, 8, and 15-18 under 35 U.S.C. § 102 based upon Hesse (U.S. Patent No. 5,287,109) can be maintained when the Examiner admits that Hesse fails to disclose, teach, or suggest the identical invention set forth in these claims.
3. Whether a rejection of claims 6-9, 11, and 15-19 under 35 U.S.C. § 103 based upon

Hesse (U.S. Patent No. 5,287,109) can be maintained when no factual evidence that might support a conclusion of obviousness is found in the record.

VII. Argument

A) Hesse Fails To Anticipate Claims 6, 8, and 15-18

Pending claims 6, 8, and 15-18 stand rejected under 35 U.S.C. § 102 as being anticipated by Hesse (U.S. Patent No. 5,287,109).

In response to the rejection of claim 6, 8, and 15-18, it is respectfully submitted that a claim is anticipated under 35 U.S.C. § 102 only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

As discussed above, the claimed invention is directed to a system and method for effecting a return to channel operation in a media playing device by, among other things, storing a primary channel indicator in memory in response to a first user action with a remote control and starting a timer in response to a second user action with the remote control such that, upon expiration of a predetermined interval timed by the timer, the remote control is caused to send a command corresponding to the primary channel indicator to the media playing device to return the media playing device to the primary channel.

Considering now Hesse, Hesse discloses a remote control having an “auto” mode which uses a *real time clock that keeps actual time of the day*, a scanner for scanning information stored in memory and for comparing that information with the time on the real-time clock, and an

actuator for effecting a command signal from the remote control to an appliance only when the time specified by the information in memory matches the time on the real time clock. (Col. 2, lines 52-63). In the “auto” mode of Hesse, the control is inputted with a sequence of commands (e.g., specifying the data and time an appliance should be turned on and the data and time the appliance should be turned off) which commands are carried out at the scheduled times as indicated by the real time clock and without having to manually operate the remote control. (Col. 3, lines 49-52 and Col. 9, lines 6-19). Thus, it is evident that the remote control of Hesse not only fails to have a timer for timing a predetermined time interval but further fails to start any time measured operation in response to a user action with the remote control or a remote control that performs any operation upon an expiration of a predetermined time interval as is expressly set forth in the subject claims.

From the foregoing it is evident that Hesse simply fails to disclose, teach, or suggest the identical invention claimed, i.e., Hesse fails to disclose each and every element set forth in the claims and, as such, Hesse simply cannot be said to anticipate claims 6, 8, and 15-18 under 35 U.S.C. § 102. For this reason it is respectfully submitted that the rejection of claims 6, 8, and 15-18 under 35 U.S.C. § 102 must be withdrawn.

B) The Examiner Has Admitted That Hesse Fails To Anticipate Claims 6, 8, and 15-18

In the Office Action of March 3, 2006 on page 4 thereof, the Examiner has admitted that Hesse does not explicitly recite the allegedly conventional return to channel instructions where an allegedly conventional system, upon a user action with the remote control, e.g., manual activation of a button, activates a timer to ultimately cause a return back to a primary program after a predetermined time.

Since these elements that the Examiner admits are missing from Hesse are elements that are expressly set forth in claims 6, 8, and 15-18, it is respectfully questioned how the Examiner could have concluded that the disclosure within Hesse anticipates claims 6, 8, and 15-18 in the first instance.

Nevertheless, since the Examiner has admitted that Hesse fails to disclose the identical invention set forth in claims 6, 8, and 15-18, it is respectfully submitted that the rejection of claims 6, 8, and 15-18 under 35 U.S.C. § 102 must be withdrawn.

C) The Record Cannot Support An Obviousness Rejection Based Upon Hesse

While the Examiner has admitted on page 4 of the Office Action of March 3, 2006 that Hesse fails to disclose the claimed timer which, in response to user input to the remote control, e.g., upon activation of a button, measures a predetermined time interval to cause a remote control to send a signal to return a media playing device to a primary channel upon expiration of the measured, predetermined time interval or the further claimed allowing a user to cause the remote control to send a signal to return the media playing device to the primary channel prior to the expiration of the measured, predetermined time interval, the Examiner has taken “official notice” that both are “well known.” While the rejection fails to make this clear, it would appear that the Examiner is then using this “official notice” to somehow conclude that it would have been obvious for one of skill in the art to modify Hesse to arrive at the identical invention that is set forth in the claims.

In response to this use of “official notice” by the Examiner, it is respectfully submitted that “it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir.

1983). More particularly, when patentability turns on the question of obviousness, the answers to the factual inquiries must be based on objective evidence of record. This need for specificity pervades the authorities. For example, see *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); *In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002); and MPEP § 2144.03 generally.

Considering now the rejection set forth on page 4 of the Office Action of March 3, 2006, it is clear that the Examiner has provided no objective evidence that might support the answers to the factual inquiries as to whether there exists in the art some suggestion or motivation to modify Hesse to arrive at the invention claimed or whether Hesse alone (which it admittedly does not) or in combination with some unspecified reference teaches or suggests all of the claim elements. For example, no evidence (or reasoning) has been presented to support the apparent conclusions to the factual inquiries that using the “manual” mode of Hesse to make it allegedly “beneficial to the user who started surfing during commercials to return to the original program when the commercials are expected to be finished or before they were...” somehow suggests modifying the “auto” mode of Hesse to thereby provide to Hesse all of those claimed elements which Hesse admittedly fails to include in the first instance. Rather, since no objective evidence has been provided to support these apparent conclusions that it would have been obvious to use the “manual” mode of Hesse to modify the “auto” mode of Hesse to arrive at all of the elements set forth in the claims, it is evident that the Examiner could only have reached these conclusions by impermissibly using “that which the inventor taught against its teacher,” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Thus, for the reason that the record fails to include any objective evidence that can be said to support an obviousness rejection, it is respectfully submitted that claims 6, 8, and 15-18 must be deemed allowable.

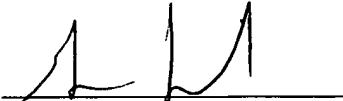
D) Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are neither anticipated by nor rendered obvious by Hesse. As such, it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: March 24, 2006

By:



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VIII. CLAIMS APPENDIX

The following is a clean copy of the claims involved in the Appeal:

6. A remote control adapted to provide a return to channel feature for a media device adapted to play media and not equipped with a return to channel feature, the remote control comprising:

 a timer for timing a predetermined interval;

 a wireless transmitter;

 memory; and

 programming stored in memory for performing steps comprising:

 storing a primary channel indicator in memory in response to a first predetermined user action,

 starting the timer in response to a second predetermined user action, and

 in response to expiration of the predetermined interval and without regard to a current state of any media being received by the media device, causing the wireless transmitter of the remote control to transmit to the media device a command signal corresponding to the primary channel indicator to cause the media device to return to the primary channel;

 wherein the command signal is selected from a library of command signals pre-established within the remote control as being appropriate for commanding various operations of the media device.

7. The remote control of claim 6, wherein the programming further comprises instructions for causing the wireless transmitter of the remote control to transmit the command signal corresponding to the primary channel indicator to the media device in response to the user repeating the second predetermined action prior to the predetermined interval expiring.

8. The remote control of claim 6, comprising a key, and wherein the second predetermined action comprises operating the key.
9. The remote control of claim 6, wherein the first predetermined user action for storing the primary channel in memory is the second predetermined user action, whereby the primary channel is stored in memory and the timer is started in response to the same predetermined user action.
11. The remote control of claim 9, wherein the first predetermined user action comprises selecting a single key of the remote control.
15. A method for effecting a return to a primary channel in a media device adapted to play media and not equipped with a return to channel feature, the method comprising:
 - in response to a user first input of a remote control, setting a timer in the remote control that times a predetermined interval;
 - storing a primary channel in memory in response to a user second input; and
 - in response to expiration of the predetermined interval timed by the timer and without regard to a current state of any media being received by the media device, causing a wireless transmitter of the remote control to transmit a command signal corresponding to the primary channel stored in memory to the media device adapted to receive the primary channel;
 - wherein the command signal is selected from a library of command signals pre-established within the remote control as being appropriate for commanding various operations of

the media device.

16. The method of claim 15, comprising, in response to a user third input, readying the remote control to receive the primary channel data in memory.

17. The method of claim 16, wherein the user first input comprises operating a key and the user second input comprises operating the key.

18. The method of claim 17, wherein the user third input comprises operating the key, including selecting the key for a duration greater than a duration required to effect one of the user first input or the user second input.

19. The method of claim 15, comprising, in response to a repeated user first input prior to the expiration of the predetermined interval, causing the wireless transmitter of the remote control to transmit the command signal corresponding to the primary channel stored in memory.

IX EVIDENCE APPENDIX

No evidence was submitted pursuant to Secs. 1.130, 1.131, or 1.132.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court or the Board in any proceedings identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37.